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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

LOPEZ, CARLOS N

ART UNIT

PAPER NUMBER

1731

DATE MAILED: 08/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/446,232

Applicant(s)

BIGGS ET AL.

Examiner

Carlos Lopez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-17 and 31-34 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1,4-17 and 31-34 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Rejections - 35 USC § 112

1) Claims 1,4-17, and 31-34 are under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The original filed specification only provides support for a smoking material comprising a tobacco content of up to 20%, see page 4 line 12ff and Examples 1-6. The specification does not support the claimed range limitation of 5 to 20% weight tobacco.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2) Claims 1,4-15, and 31-34 are rejected under 35 U.S.C. 103(a) as being as being unpatentable over Gibson et al (US 3878850). Gibson discloses a smoking material having a non-polyol aerosol generator, up 20% by weight tobacco, binder and inorganic filler (Column 4, Ins. 34-46). As for claims 4-5, the non-polyol aerosol generator being glycerol triacetate, 5% by weight (Column 4, Ins. 34-46). As for claims 6-8, 14 and 33, the inorganic filler, calcium carbonate being present by 45% in weight (Column 4, Ins.

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34-46). As for claims 9 and 10, there is no tobacco present in the smoking material, 0% (Column 4, Ins. 34-46). As for claims 11-13, and 15 34, the binder, carboxymethyl cellulose, being present not more than 20% (Column 4, Ins. 34-46). The instant specification as originally filed does not show a patentable distinction between 5 and 6% non-polyol aerosol generator. Additionally, glycerol triacetate is a compound shown by Gibson et al to provide desired effects in the smoke profile (Column 4, lines 51-62). Hence, it would have been obvious to a person of ordinary skill in the art to have increased the amount of glycerol triacetate from 5% to 6% in order to increase the benefits disclosed by Gibson et al.

As for claim 32, a polyol aerosol generator is present at 8.5% (Example 1).

The newly added limitation of 5 to 20% tobacco is deemed to be met by Gibson et al when considering Gibson's material (substrate) is blended with up to 80% tobacco. Gibson's substrate blended with up to 80% tobacco as recited in claim 3 of Gibson and in Col.1 line 67, is deemed as the claimed smoking material and thus the claimed 5-20% is clearly envisaged by Gibson.

3) Claims 16 and 17 rejected under 35 U.S.C. 103(a) as being unpatentable over Gibson et al (US 3878850). As disclosed above Gibson meets all the limitations of claim 1, from which claims 16 and 17 are dependent on. Gibson is silent on using an expansion medium or high oil containing materials. However, Gibson teaches that said smoking material may contain flavourants. It is well in known in the art that cocoa, having high fat content, is used as a flavourant. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have

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included flavourants as taught by Gibson such as cocoa, as conventionally used, to enhance the smoking experience.

Response to Arguments

Applicant's arguments filed 6/12/03 have been fully considered but they are not persuasive. Applicant traverses the rejections made to claims 1, 4-15, and 31-34 under 35 U.S.C. 103(a) over Gibson. Applicant alleges that Gibson's smoking material is comprised of 50% tobacco as shown in the examples. While Gibson's examples disclose smoking material being mixed with natural tobacco (Column 1, lines 31-32) at 50%, it is noted that Gibson also teaches that the smoking material may be blended with **up to** 80% tobacco (See Column 1, lines 65ff and claim 3).

Applicant argues that Gibson's specification "utilizes this term, substrates, in defining the testing material and the term is not being utilized as a definition for a formed material utilized in the examples. This is supported additionally by be the claims which set forth a smoking mixture comprising a smoke producing substrate, the substrate being be entire combined material of be film blended with the added tobacco". Applicant's argument is not persuasive in view that Gibson's abstract teaches that smoking mixture (now deemed as the claimed smoking material) refers to the smoke producing substrate as a tobacco substitute or a blend with tobacco.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos Lopez whose telephone number is (703) 605-1174. The examiner can normally be reached on Mon.-Fri. 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on (703) 308-1164. The fax phone numbers

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for the organization where this application or proceeding is assigned are (703) 305-7718 for regular communications and (703) 305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

C.L
August 6, 2003

A handwritten signature in black ink, appearing to read 'Peter Chin', with a stylized flourish at the end.

PETER CHIN
PRIMARY EXAMINER